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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,375	09/30/2003	Albert A. Maltan	0158-031 (05-00628-02)	6859
67074 7590 06/20/2007 HENRICKS SLAVIN AND HOLMES, LLP ADVANCED BIONICS CORPORATION 840 APOLLO STREET SUITE 200 EL SEGUNDO, CA 90245			EXAMINER MALAMUD, DEBORAH LESLIE	
			ART UNIT 3766	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,375

Applicant(s)

MALTAN ET AL.

Examiner

Deborah Malamud

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges the amendments received 20 April 2007. Claims 1-25 are pending.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: Specifically, a corrected statement should read, "I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations 1.56."

Claim Objections

3. In view of the amendments received 20 April 2007, the examiner withdraws the objection to claim 9 for minor informalities.

Response to Arguments

4. Applicant's arguments filed 20 April 2007 have been fully considered but they are not persuasive. The applicant argues, (page 10, "Remarks") "The Faltys patent [previously cited prior art] indicates that "the batteries employed within the wearable unit 102 (FIG. 1A) or the BTE unit 120 (FIG. 1B) may be readily replaced when needed."

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[Column 9, lines 19-21.] As such, the power source in the speech processor illustrated in Figure 1A simply is not "permanently integrated into" the wearable unit 102." The examiner had relied, in the previous Non-Final Office Action, on the obviousness of forming in one piece an article that has formerly been formed in two pieces, citing case law that the applicant has called into question. Though the examiner acknowledges that *Howard v. Detroit Stove Works* in this case was not precisely applicable, the rationale for applying an obviousness rejection under U.S.C. 103(a) is maintained.

5. In the applicant's own specification (par. 0013), it is noted that "[a] sound processor that has its own integrated power source and the ability to be recharged and programmed through RF in accordance with the present invention may be worn or carried in several locations outside the body, including behind the ear, clipped to the users hair or article of clothing, hanging from a necklace, carried in a shirt or blouse pocket, etc." The examiner maintains that Faltys patent, in previously cited paragraphs, does perform this function, which is to say an external module that includes (col. 7, lines 59-67 Figures 1A) a speech processor (SP), a power source, and a headpiece (HP; 106), which may comprise a microphone (107). Inside of the headpiece is a coil (col. 8, lines 8-10) that is used to inductively or magnetically couple a modulated ac carrier signal to a similar coil that is included within the ICS (112). It is further noted in the applicant's specification (par. 0014-0016) that "[a] sound processor having its own integrated power source in accordance with the present invention also advantageously avoids the need to replace small batteries, or adjust small controls on the device, thereby eliminating the need for good manual dexterity in use of the device. As a result,

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the device is much more user friendly for the elderly or others who lack good manual dexterity. A sound processor having its own integrated power source in accordance with the present invention further eliminates the need for the user to carry spare batteries. Moreover, because no batteries of any kind are needed (except for the remote control, which may be of the conventional AA or AAA size, and are long-lasting), there are no spare or other batteries lying around which could pose a choking hazard for young children. Finally, a sound processor having its own integrated power source in accordance with the present invention may be made much smaller and be more reliable than equivalent units that use replaceable batteries. According to the present invention, the extra components needed to support a removable battery--mechanical latches or doors, connectors, etc.--may be eliminated, allowing the size of the sound processor to be smaller and removing potential failure mechanisms." It appears from this explanation of the benefits of a permanently integrated power source, such as claimed by the applicant, that a non-removable battery differs from a replaceable battery only in the fact that it *can* be removed, if so desired. This constitutes an intended use for the claimed invention. It is to be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The examiner considers the system of Faltys capable of performing the claimed function of being permanently integrated to the sound processor, because a patient may choose not to remove the battery, or to allow a physician, care-provider, or family

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member to replace it. The battery of Faltys is therefore integrated until someone removes it; Faltys' external portion is also capable of being removed in its entirety, in order to replace the battery.

6. The examiner thanks the applicant for addressing the rejection of claim 21, in page 9 of "Remarks." This claim was indeed intended to be rejected under 35 U.S.C. 103(a).

7. It is also to be noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Since many of the independent claims rely on the phrase "adapted to" perform a claimed function, the examiner recommends changing this phrase throughout the claims to, for example, "configured to."

8. The applicant further argues (pages 12-14, "Remarks"), in regards to claims 9 and 17, "The Bordewijk patent [previously cited reference], which has been cited for its purported remote control teachings, fails to remedy the battery-related deficiencies in the Faltys patent." The examiner notes that the response provided above to arguments regarding claim 1 are applicable in this case as well.

9. The applicant further argues (page 15, "Remarks") that "the Office Action failed to identify the structures in one of the Faltys devices that perform the functions discussed above. Additionally, the Office Action did not indicate which portions of the invention defined by claim 25 are not disclosed in the Faltys patent and/or provide reasons for a modification of one of the Faltys devices that would produce claimed combination.

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Applicant hereby requests that the next Office Action perform the analysis required for rejections under 35 U.S.C. §§ 103 and 112, sixth paragraph, in order to clarify the issues in this application.” The examiner will therefore outline which of the features of Faltys correspond to the claimed features, for clarification. Faltys discloses (col. 9, lines 8-18) “a behind-the-ear (BTE) unit (120) has been proposed, as illustrated in FIG. 1B. The BTE unit may include everything that was previously included within the wearable unit (102) [external components, such as speech processor, a power source, and a headpiece including a microphone], only in a much smaller volume. The BTE unit thus includes a suitable power source, as well as the circuitry needed for performing a desired speech processing function. With the BTE unit, there is thus no need for the cable, and the patient simply wears the BTE unit behind his or her ear, where it is hardly noticed, especially if the patient has hair to cover the BTE unit.” The examiner considers this to be means for mounting the microphone, sound processing circuit and rechargeable power source behind the human ear. Faltys further discloses, (col. 8, lines 24-36) “a carrier signal is generated by circuitry within the wearable unit (102) [equally applicable to BTE unit 120, as explained by the above cited Faltys patent] using energy derived from the power source within the speech processor unit. Such carrier signal, which is an ac signal, is conveyed over the cable to the headpiece (106) where it is inductively coupled to the coil within the ICS (112). There it is rectified and filtered and provides a dc power source for operation of the circuitry within the ICS. Sounds are sensed through the external microphone (107), amplified and processed by circuitry included within the speech processor unit, and converted to appropriate stimulation

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signals in accordance with a selected speech processing strategy by circuitry within the speech processor unit." The examiner considers this to be means, carried by the means for mounting, for transferring power from an external power source to the rechargeable power source.

10. The applicant further argues (page 16, "Remarks") "the presence or absence of a battery removal door on the ISP, i.e. the implantable speech processor, has nothing whatsoever to do the presence or absence of a battery removal door on the external components illustrated in Figure 1A of the Faltys patent, i.e. the purported "sound processor."" The examiner acknowledges that claim 21, rather than claim 20, was intended to be addressed by the discussion on pages 7-8 of the previous Non-Final Office Action, and thanks the applicant for addressing this matter. However, the arguments presented by the examiner as pertaining to the ISP are equally applicable to the external sound processor: Faltys' system makes no mention of a power source removal door, and furthermore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a sound processor case that does not include a power source removal door, since such a door would be unnecessary for a battery that is not to be removed from the sound processor.

11. For these reasons, as well as for others discussed in the previous Non-Final Office Action, the rejections to the claims are maintained.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1-4, 6-7, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltys et al (U.S. 6,272,382); claims 5 and 8 over Faltys et al (U.S. 6,272,382) in view of Single (U.S. 2002/0076071); claims 9-13, 15, 17-20 and 22-24 over Faltys et al (U.S. 6,272,382) in view of Bordewijk (U.S. 4,918,736); claim 14 over Faltys et al (U.S. 6,272,382) in view of Bordewijk (U.S. 4,918,736) and in further view of Single (U.S. 2002/0076071); and claim 16 over Faltys et al (U.S. 6,272,382) in view of Bordewijk (U.S. 4,918,736) and in further view of Schulman (U.S. 3,942,535). For a complete discussion of the claimed elements, please see above, and the previous Non-Final Office Action.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Malamud whose telephone number is (571) 272-2106. The examiner can normally be reached on Monday-Friday, 9.00am-5.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


CARL LAYNO
PRIMARY EXAMINER


Deborah L. Malamud
Patent Examiner
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